

Appl. No. : 09/457,839
Filed : December 9, 1999

REMARKS

This Amendment is responsive to the Office Action mailed on June, 1, 2004 (hereinafter "the Office Action"), for which the response period was restarted by the Office communication mailed on September 7, 2004. Initially, Applicants' representative would like to thank Examiner Sherr for the courtesy she extended during the telephone interview conducted on December 20, 2004.

I. Substance of Telephone Interview

During the telephone interview, Applicant's representative and the Examiner discussed proposed claim amendments similar to the amendments made herein. In addition, in each independent claim, Applicant's representative pointed out representative claim limitations that, he believes, are not disclosed or suggested by the applied references (as reiterated below). The Boesch *et al* and Katis patents were discussed during the interview, and no exhibits were presented.

II. Summary of the Amendments

By the foregoing amendments, Claims 31-35, 40, 53-59 and 65 have been canceled and Claims 36, 39, 41, 60, 66 and 67 have been amended. In addition, the abstract of the disclosure has been revised to comply with the 150-word limit. No new matter has been added.

III. Rejection of Claims 36 and 41 Under Section 112, Second Paragraph

As proposed during the telephone interview, Applicant has deleted the objected-to phrase "and without providing payment information to" from Claims 36 and 41. In view of this deletion, Applicant requests that the Examiner withdraw the rejection of Claims 36 and 41 under section 112, second paragraph.

IV. Obviousness rejection of Claims 44 and 45

Independent Claim 44, and Claim 45 which depends from Claim 44, stand rejected on obviousness grounds over Boesch *et al* (U.S. Pat. 6,092,053) in view of Foster (U.S. Pat.

Appl. No. : 09/457,839
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6,332,134) and Lineman (U.S. Pat. 6,327,578). Applicant submits that this rejection is improper because these references do not disclose or suggest the following limitations of Claim 44:

generating an interests profile that reflects said purchases made by the first user from the plurality of online merchants; and
transmitting the interests profile of the first user to a web site system of at least one online merchant to allow the online merchant to provide personalized web site content to the first user.

In connection with these limitations, the Examiner appears to rely primarily on Boesch *et al*, which discloses a consumer information server (CIS) that disseminates payment information of consumers to online merchants. See Office Action at paragraph 13, citing col. 2, line 21 to col. 4, line 54 of Boesch *et al*. Boesch *et al* does not, however, disclose or suggest the generation of an interests profile that reflects a user's purchases made from a plurality of online merchants. The brief disclosure at col. 2, lines 49-52, that the CIS software may generate a profile "based on the preferences chosen by the consumer or created by the CIS software based on the consumer's behavior....," does not suggest this feature.

Moreover, nothing in Boesch *et al* suggests that the profile generated by the CIS software is ever transmitted "to a web site system of at least one online merchant to allow the online merchant to provide personalized web site content" to the user. Rather, the profile is apparently generated so that "[t]he CIS software can tailor its communication with the consumer's computer" See Boesch *et al* at col. 4, lines 47-50.

Because Boesch *et al*, Foster and Lineman do not individually or collectively disclose the above-quoted limitations of Claim 44, the rejection of Claims 44 and 45 is improper. Applicant also respectfully submits that the rejection of Claims 44 and 45 is improper because the Examiner has not identified a suggestion or motivation in the prior art to combine these three references.

V. Obviousness rejection of Claims 46-52 and 60-64

Claims 46-52 and 60-64 stand rejected on obviousness grounds over Katis (U.S. Pat. 6,601,761). Applicant respectfully submits that this rejection is improper because Katis does

Appl. No. : 09/457,839
Filed : December 9, 1999

not disclose or suggest all of the limitations of independent Claims 46 and 60. For example, with respect to Claim 46, Katis does not disclose or suggest the following steps in the context of the other claim limitations:

providing, in a web page of the merchant web site and in conjunction with a description of a purchasable item, a reference to a graphic served by the information service server, such that when a browser running on the computer of the user retrieves the web page, the browser is caused to request the graphic from, and transmit the cookie to, the information service server; and

at the information service server, in response to receiving the cookie and a request for the graphic from the computer of the user, returning to the computer of the user a single-action purchase graphic indicating that the item may be purchased with a single selection action, said single-action purchase graphic being selectable by the user to purchase the item.

With respect to Claim 60, Katis does not disclose or suggest the following within the context of the other claim limitations:

providing, within coding of the web page, a reference to a graphic served by the server, such that when a browser retrieves the web page, the browser is caused to request the graphic from the server; and

when a browser running on the computer of the user retrieves the web page from the web site and sends a resulting request for the graphic to the server, responding to the request by at least: (a) using the cookie transmitted with the request to identify the name of the user, (b) incorporating the name of the user into an image, and (c) returning the image to the user computer for display within the web page.

The Office Action does not appear to address the foregoing limitations of Claims 46 and 60.

In view of the foregoing, Applicant submits that independent Claims 46 and 60, and corresponding dependent Claims 47-52 and 61-64, are patentably distinct from Katis. Applicant additionally submits that dependent Claims 47-52 and 61-64 recite additional patentable distinctions over Katis.

Appl. No. : 09/457,839
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VI. Claims 67-69

The Office Action does not set forth any basis for rejecting Claims 67-69. As discussed during the telephone interview, the methods defined by these claims are not disclosed or suggested by the applied references.

VII. Conclusion

By pointing out distinctions over Boesch *et al*, Foster, Lineman and Katis, Applicant does not imply or admit that any of these references is "prior art." Applicant reserves the right to swear behind one or more of these references in the future. In addition, by focusing on specific claims and claim limitations in the discussion above, Applicant does not imply that other claims and claim limitations are disclosed or suggested by the prior art.

In view of the foregoing amendments and remarks, Applicant requests that the Examiner withdraw the objection to the abstract, withdraw the rejections of the pending claims, and issue a Notice of Allowance.

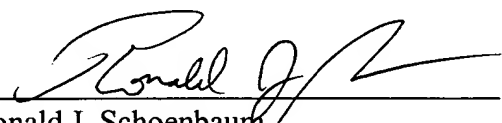
If any issues remain in the present application, the Examiner is requested to call the undersigned representative at his direct dial number of 949-721-2950.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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